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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,366	05/28/2008	Guy Georges Aubin	BEAUMONT-38	8435
45722	7590	12/21/2011	EXAMINER	
Howard IP Law Group P.O. Box 226 Fort Washington, PA 19034			HUGHES, KEVIN G	
			ART UNIT	PAPER NUMBER
			2193	
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			12/21/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,366	Applicant(s) AUBIN, GUY GEORGES	
	Examiner KEVIN G. HUGHES	Art Unit 2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1, 4-9 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☒ Claim(s) 5-9 is/are allowed.
- 7) ☒ Claim(s) 1 and 4 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 4 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims recite collecting data, delaying data, and combining data without tying the method to a **particular** machine, performing a physical transformation, or transforming an article representing a physical and tangible object. Claims also correspond to the following factors weighing against eligibility detailed in the Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski and Kappos* dated July 27, 2010:

- No recitation of a machine or transformation (either express or inherent).
 - Insufficient recitation of a machine or transformation.
 - Involvement of machine, or transformation, with the steps is merely nominally, insignificantly, or tangentially related to the performance of the steps, e.g., data gathering, or merely recites a field in which the method is intended to be applied.
 - Transformation involves only a change in position or location of article.
 - “Article” is merely a general concept.
 - The claim is a mere statement of a general concept.
 - Use of the concept, as expressed in the method, would effectively grant a monopoly over the concept.
 - **Both known and unknown uses of the concept are covered, and can be performed through any existing or future-devised machinery, or even without any apparatus.**
 - The general concept is disembodied.
 - The mechanism(s) by which the steps are implemented is subjective or imperceptible.
- Therefore, claims are rejected as being directed towards nonstatutory subject

matter.

Allowable Subject Matter

Claims 5-9 allowed.

Response to Arguments

Applicant's arguments filed with regards to 35 USC 101 have been fully considered but they are not persuasive.

Applicant's arguments filed with regards to 35 USC 102 and 103 have been fully considered and are persuasive. The art rejection of claims 1 and 4-9 has been withdrawn.

Applicant argues on pages 5-7 that data is transformed (Page 5, Line 8) and combined with a recirculation loop that additionally ties the method to a tangible article (Page 6, Line 14).

The examiner respectfully submits that the method fails the machine and transformation test as the limitations fail to include explicitly or inherently hardware or a transformation of an article to a different state or thing. The method further fails to satisfy additional factors that would make the claim statutory. With regards to the applicants statement that a transformation occurs, the examiner respectfully submits that the input of the method is data, specifically a bit stream of random bits, and that the output of the method is data, specifically a bit stream of random bits. The 'Interum Examination Instructions for Evaluating Subject Matter Eligibility Under 35 USC 101' published August 24, 2009 specifically states "Transformation of an article means that

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the article has changes to a different state or thing... A new or different function or use can be evidence that an article has been transformed... For data, mathematical manipulation per se has not been deemed a transformation; but, transformation of electronic data has been found when the nature of the data has been changed such that it has a different function or is suitable for a different use." As claimed, the data manipulations of the random bit stream fail to render the data useable for a different function or use, therefore, no transformation has taken place.

The examiner respectfully submits that 'recirculation loop' fails to tie the method steps to a tangible article. A recirculation loop, or feedback loop as commonly named in the art, can be implemented in hardware as a physical wire, register, or other embodiments, or in software as a variable, parameter, or other embodiments. The recitation that a recirculation loop exists fails to tie the claim to a statutory category as it is not a particular machine or apparatus or a transformation of a particular article.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN G. HUGHES whose telephone number is (571)270-3365. The examiner can normally be reached on Monday through Friday from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis Bullock can be reached on 5712723759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lewis A Bullock, Jr./
Supervisory Patent Examiner, Art Unit 2193

/KEVIN G HUGHES/
Examiner, Art Unit 2193